

the Examiner's position, on the basis of which allowance of the application is respectfully requested.

Claim Rejections - 35 U.S.C. §103

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro (1,859,105) in view of Zaparka (2,049,555). This rejection is traversed.

In framing the rejection of claims 1-12, the Examiner has repeated the text of his rejection in the first Office Action. With regard to claims 15-18, the Examiner points to structures in Munro, particularly Fig. 2, elements 4 and 15, for a structure that is alleged to read on the limitations in these claims.

In the prior Amendment, claim 1 was specifically amended in the preamble to identify the originally claimed "reinforcing holder" to be operative "against seismic vibrations for joining structural members in a building." Further, the "reinforcing base member" in the body of the claim was described as "being fixed to said structural members via said absorbing members" in order to tie the structure of the reinforcing holder to the "structural members in a building". Further, new claim 13 was specifically directed in the preamble to "a reinforcing holder against seismic vibrations for joining structural members in a building," and the body of the claim specifically referred to "a first structural member" and "a second structural member". Clearly, these are structural members in the building identified in the preamble.

In response to the amendments and arguments made, the Examiner admits that the claimed invention is directed to earthquake protection. The Examiner also admits that the prior art is directed to vehicles. The Examiner further admits that "the instant application and the prior art combination are different devices but they are used to solve the same problem of damping vibrations."

On the basis of applicable law, the Examiner is mistaken in his analysis. Vibration is encountered in a broad spectrum of devices including false teeth, bridges, vehicles, printers, manufacturing machines, toys, etc. It is clear error for the Examiner to insist that the technology of any one of these diverse applications may be simply applied to other applications without

considering their different environments. Structures appropriate for a toy are clearly not appropriate for a bridge. Similarly, structures for a building are not appropriate for a vehicle. The nature of the vibrations are different particularly with respect to intensity, direction and frequency, and the requirements for the building and the vehicle are totally different. The requirement for the building is to maintain intense loads in a stationary structure, which may be subject to infrequent but violent vertical and lateral forces. The requirement for the vehicle is to provide a smooth ride to passengers in a moving structure. Clearly, the direction of the forces as well as their magnitudes and frequencies are quite different.

The law and practice related to preambles in claims, as reflected in the MPEP 2111.02, requires the content of the preamble to be considered as a limitation of the claim.

"[A] claim preamble has the import that the **claim as a whole suggests** for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is **'necessary to give life, meaning, and vitality' to the claim**, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, **the preamble served to further define the structure of the article produced.**).

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on **review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."**); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071

(Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar, however the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.). (emphasis added)

Clearly, on the basis of the foregoing guidance and decisions by the Federal Circuit, the Applicants have invented a reinforcing holder for building structures, as disclosed and claimed. The specification does not disclose anything else. The claims specifically state the environment for the structure, and the body of the claim expressly ties the claimed structure to the environment in the preamble. The preamble provides more than a simple statement of purpose, but provides a structural difference from the prior art. There can be no doubt that the present claims fall within the category of inventions that the courts and USPTO under the above quoted policy in the MPEP would find to be properly defined and limited by statements in the preamble.

Finally, Applicant notes that the Examiner's suggestion that the body of the claim must claim the building in combination with the reinforcing holder is simply not good law. It is the reinforcing holder that is new, that is the product to be sold and the product against which infringement is to be protected by the claims of the present application when issued.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

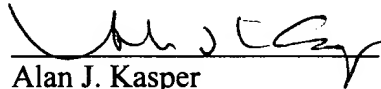
AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/936,363

Q65398

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpay/ents to said Deposit Account.

Respectfully submitted,

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